

# **Exhibit A, Part 1**

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11  
12 **UNITED STATES DISTRICT COURT**  
13 **CENTRAL DISTRICT OF CALIFORNIA**  
14 **SOUTHERN DIVISION**

15 ACACIA MEDIA TECHNOLOGIES  
16 CORPORATION,

17 Plaintiff,

18 vs.

19 NEW DESTINY INTERNET GROUP,  
20 et. al.,

21 Defendants.

22 AND ALL RELATED CASE ACTIONS.

Case No. SACV 02-1040 JW (MLGx)

**PLAINTIFF ACACIA MEDIA  
TECHNOLOGIES  
CORPORATION'S CLAIM  
CONSTRUCTION BRIEF**

**DATE: February 6, 2004**  
**TIME: 10:00 a.m.**  
**CTRM: Hon. James Ware**

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1 **I. BACKGROUND TO ACACIA'S U.S. PATENT NO. 5,132,992**

2 Today, transmitted digital video is taken for granted. We can view digital  
3 video material from many transmission sources, such as the Internet, cable television,  
4 and satellite television. Using those sources, we can now select a movie and watch it  
5 at a time of our choosing, without ever leaving our home.

6 This was not the case in early 1990. Then, if a person wished to view a  
7 selected movie at their home at a time of their choosing, they would have to rent or  
8 purchase the movie on videotape or a laserdisc. This required one, and sometimes  
9 two, trips from the home to the video store. While these methods of viewing movies  
10 were accepted and widely used in the United States at that time and now, there  
11 remained a pressing, long felt need for a system which would permit persons to view  
12 movies at their homes at a time of their choosing—without having to leave their  
13 homes.

14 In early 1990, Paul Yurt and H. Lee Browne sought to solve this problem. Yurt  
15 and Browne collaborated to develop a digital communication system that would,  
16 among other things, permit a person to receive transmissions of audio, video, and/or  
17 audiovisual programs at their home, or other location, which the person could play  
18 back as it was being received or which the person could retain for playback at a later  
19 time of the person's choosing.

20 On January 7, 1991, Yurt and Browne filed a patent application with the United  
21 States Patent and Trademark Office for their invention entitled: "Audio and Video  
22 Transmission and Receiving System." This application issued as United States Patent  
23 No. 5,132,992 on July 21, 1992 (the '992 patent). (the '992 patent is attached to the  
24 Appendix as Exhibit 1; the file history for the '992 patent is attached to the Appendix  
25 as Exhibit 2).<sup>1</sup> Four additional continuation patents have issued thereafter, including  
26  
27

28 <sup>1</sup> All references to Exhibits in this brief refer to the Exhibits attached to the  
accompanying Appendix of Exhibits, which is filed concurrently herewith.

1 U.S. Patent No. 6,144,702, which issued on November 7, 2000 (the '702 patent)<sup>2</sup>.

2 Yurt and Browne invented a comprehensive digital transmission and receiving  
3 system with many features<sup>3</sup>:

- 4 1. the user may remotely select audio/video material from any location that  
5 has either telephone service or a computer. ('992 patent, 1:62-66<sup>4</sup>);
- 6 2. the system transmits over one or more existing communication  
7 channels.<sup>5</sup> ('992 patent, 1:67-2:4; 15:65-16:15; 16:53-68; 19:24-27;  
8 Figs. 2b and 6);
- 9 3. the system transmits, receives, and plays back only audio information,  
10 only video information, or a combination of audio and video information.  
11 ('992 patent, 2:11-15);
- 12 4. the system can transmit information in a fraction of real time to any  
13 specified receiver. ('992 patent, 1:67-2:4);
- 14 5. the system permits the user to play back the information at any time  
15 selected by the user. ('992 patent, 2:5-8);

16  
17 <sup>2</sup> In this case, Acacia contends that defendants are infringing claims of the '992  
18 and '702 patents. The '702 patent, being a continuation of the '992 patent, has the  
19 same effective filing date as the '992 patent -- January 7, 1991 -- and has the same  
20 specification and figures as the '992 patent (although the same text is printed at  
different columns and line numbers for each patent). This motion relates only to the  
claims of the '992 patent.

21 <sup>3</sup> These features are not limiting with respect to any of the claims of the patents,  
22 unless explicitly stated in any claim. Nothing in the specification of the '992 patent  
23 requires that every embodiment of the invention include these features. See, E-Pass  
24 Technologies, Inc. v. 3Com Corporation, 343 F.3d 1364, 1370 (Fed. Cir. 2003) ("An  
invention may possess a number of advantages or purposes, and there is no  
requirement that every claim directed to that invention be limited to encompass all of  
them.")

25 <sup>4</sup> Throughout this brief, Acacia shall cite to the '992 patent using the convention  
of column:line-line or column:line - column:line.

26 <sup>5</sup> The '992 patent identifies non-limiting examples of communication channels,  
27 such as standard telephone, ISDN, B-ISDN, microwave, DBS (direct broadcast  
28 satellite), cable television systems, metropolitan area networks, local area networks,  
high speed modems, communication couplers, VHF, or UHF broadcasting systems.  
( '992 patent, Fig. 2b; 4:661-63; 15:65-16:15 and 16:53-69).

- 1           6.     the system permits the user to retain a copy of the information for
- 2                 multiple playbacks in the future. ('992 patent, 2:8-10);
- 3           7.     the system permits the conversion of disparate input source material<sup>6</sup> into
- 4                 a compatible format for ease of transmission, receipt, and playback by
- 5                 many users at many locations. (see, e.g., '992 patent, 5:66-6:22); and
- 6           8.     the system permits the user to play back the program using playback
- 7                 controls similar to those used on a standard recorder, such as play, fast
- 8                 forward, rewind, stop, pause, and play slow. ('992 patent, 17:35-38).

9           This feature-laden invention of Yurt and Browne is disclosed in the '992 patent,  
10 which details how source material programs are formatted and transmitted to remote  
11 locations, and how the formatted programs are requested, received and played back.

12           There are 58 claims in the '992 patent, comprising six categories of system and  
13 method claims [transmission system claims (1-18); distribution method claims (19-  
14 24); receiving system claims (25-40); method of transmission claims (41-46);  
15 distribution system claims (47-53); and method of receiving information claims (54-  
16 58)]. To best introduce the Court to the novel technology invented by Yurt and  
17 Browne and to explain the way it works in an understandable manner, it is desirable  
18 that we examine a disclosed embodiment of their invention which is relevant to the  
19 claims-at-issue in this case,<sup>7</sup> and, more particularly, examine in that embodiment the

---

21           <sup>6</sup> The '992 patent identifies non-limiting examples of different types of source  
22 material items of information: "television programs, movies, audio recordings, still  
23 pictures, files, books, computer tapes, computer disks, documents of various sorts,  
24 musical instruments, and other physical objects [musical instruments and physical  
25 objects are meant to refer to live events, which can be recorded]. . . The different  
media formats preferably include digital or analog audio and video tapes, laser disks,  
film images, optical disks, magnetic disks, computer tapes, disks, and cartridges."  
( '992 patent, 6:12-15 and 6:19-22).

26           <sup>7</sup> In this case, Acacia contends that all of the defendants are involved with  
streaming video and therefore are infringing claims 1, 2, 4, 6, 8, 9, 10, 18, 41, 42, 43,  
44, 45, and 46 of the '992 patent and claims 14 and 41 of the '702 patent.  
27 Additionally, Acacia contends that defendants Game Link, Inc. and AEBN, Inc. also  
infringe claims 19, 22, and 24 of the '992 patent and claims 1-4, 6, 8-13, 15, 17-32,  
28 and 34-40, because these are the only defendants who, in addition to providing users  
with streaming videos, also permit users to store a copy of the selected video.

described system elements and steps to: (1) store source material programs (e.g. items of information) in a library; (2) assign each item of information a unique identification code so that the program can be located and accessed later; (3) convert and format separate items into a compatible digital format, (4) place the formatted material in an order or sequence (i.e., using time codes); (5) compress the formatted, ordered data blocks; (6) store the formatted, ordered, and compressed data blocks as a file in a storage library; (7) transmit at least a portion of the file to a remote location; (8) receive the compressed, digital information; (9) store (temporarily or for longer periods of time) at least a portion of the information; (10) decompress the information; and (11) play back the information using playback controls. Notably, this description of embodiment does not limit the scope of the claims, which are broader. This description is provided for illustrative purposes only.

**1. Description Of System Elements And Steps From The Disclosed Embodiments Of The '992 Patent**

**a) Store Source Material Programs (e.g., Items Of Information) In A Library**

Like the local Blockbuster outlet “stores” videos, the source material library (111) of the ‘992 patent stores “items of information [which] may include analog and digital audio and video information as well as physical objects such as books and records.” (‘992 patent, 6:2-4). The source material library (111) stores “different types of materials including television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects.”<sup>8</sup> (‘992 patent, 6:12-15). Items of information may be in different media formats, such as digital or analog video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, and

---

<sup>8</sup> This storage may be permanent or temporary: “. . . a preferred embodiment of the present invention preferably includes source material library means for temporary storage of items prior to conversion.” (‘992 patent, 5:66 - 6:1).

1 cartridges. ('992 patent, 6:19-22).

2                                   **b)     Assign Each Item Of Information A Unique**  
3   **Identification Code So That The Program Can Be**  
4   **Located And Accessed Later**

5           Just as a librarian uses the Dewey Decimal System to separately identify each  
6 book in a library, each item of information is separately assigned a unique  
7 identification code which may be used to identify, request, locate, and access the item  
8 throughout the system. ("Prior to being made accessible to a user of the transmission  
9 and receiving system of the present invention, the item must be . . . given a unique  
10 identification code by identification encoder 112.") ('992 patent, 6:35-39; See also,  
11 6:40-54; 10:58-65; 11:22-28; 14:22-28; 18:53-68).

12           Individual items of information are also separately retrieved from the source  
13 material library. Retrieving the information in the items is "analogous to taking books  
14 off of a shelf at the local public library after the person has decided that he or she  
15 would like to read them." ('992 patent, 18:53-59). An example of retrieved  
16 information from the source material library is a motion picture film. ('992 patent,  
17 7:35-37).

18                                   **c)     Convert And Format Separate Source Material**  
19   **Programs Into A Compatible Digital Format**

20           The items of information in the source material library may be in many  
21 different analog or digital formats. In order to be transmitted in a form that can be  
22 transmitted, received and played back, the items of information need to be converted  
23 to a predetermined, compatible digital format for further processing by the converter  
24 (113), which includes input receivers (124 and 127) (for analog or digital items) and  
25 formatters (123 and 125). ('992 patent, 6:55 - 7:58).

26                                   **d)     Order The Formatted Material (i.e., Assign Time Codes)**

27           Because audio/video content has a time element (i.e., frames/second or  
28 samples/second), the time relationship of data blocks within the audio/video content



1 must be preserved throughout the system. Each data block is time encoded, using a  
2 time encoder, so that a relative relationship of one addressable data block to another is  
3 created. By this process, each item of information, previously transmitted, is now  
4 placed into a sequence of addressable data blocks, i.e., it is time encoded by a time  
5 encoder (114): "Time encoding by time encoder 114 is achieved by assigning relative  
6 time markers to the audio and video data." ('992 patent, 8:16-19; See also, 7:59 - 8:15  
7 and 8:20-56). Time encoding of the data blocks is important, because "[r]ealignment  
8 of audio and video data, system addressing of particular data bytes, and user  
9 addressing of particular portions of items are all made possible through time  
10 encoding."<sup>9</sup> ('992 patent, 8:20-23).

11 **e) Compress The Formatted, Ordered Data Blocks**

12 Bandwidth limits transmission capabilities. Therefore, to facilitate  
13 transmission, the addressable, time encoded data blocks are data compressed in  
14 compressor 116 (audio data may be compressed separately (128) from the video data  
15 (129)). ('992 patent, 9:41 - 10:16). No specific compression algorithm is required,  
16 although the '992 patent discloses that "video data compression preferably involves  
17 applying two processes: a discrete cosine transform, and motion compensation."<sup>10</sup>  
18 ('992 patent, 10:7-9). Further, the compression algorithm operates on blocks of data:  
19 "Audio and video information is preferably converted into blocks of data organized in  
20 groups for compression processing by audio compressor 128 and video compressor  
21 129, respectively. These blocks are organized as frames, and a number of frames are  
22

---

23  
24 <sup>9</sup> After being placed into a sequence of addressable data blocks, the sequenced  
25 data blocks may then be sent to a precompression processor 115. In the  
26 precompression processor, the data blocks are buffered prior to being compressed and  
they may be undergo additional formatting, e.g., aspect ratio conversion. ('992  
patent, 8:57 - 9:40). The precompression processor is shown in Figure 2a, but it is not  
part of either claim 1 or claim 41 of the '992 patent.

27 <sup>10</sup> Discrete cosine transform and motion compensation are utilized in most of the  
28 popular compressors in use today, particularly MPEG-2, Windows Media, Real, and  
Apple.

1 contained respectively in the buffers 130 and 131. By analyzing a series of frames it  
2 is possible to optimize the compression process.” (‘992 patent, 9:50-57).

3 **f) Store The Formatted, Ordered, And Compressed Data**  
4 **Blocks As A File In A Storage Library**

5 Following compression, the addressable, time encoded data blocks of one of the  
6 items may be formatted into a single file (i.e., the audio and video data is recombined)  
7 in the compressed data formatting section (117). (‘992 patent, 10:17-30). The file  
8 may then be stored in a compressed data library (Figure 2b) (118). The compressed  
9 data library is preferably a mass storage device for storing multiple files. (‘992  
10 patent, 10:31-45).

11 Each file stored in the compressed data library is addressable by the unique  
12 identification code assigned to that item. (‘992 patent, 10:28-30; 11:22-25). The  
13 system operates on multiple items by executing on each item individually. This is  
14 apparent from the methodology taught in the patent: each item of information is  
15 given a unique identification code; each item, following compression, is placed in a  
16 file; each file is addressable through the unique identification code; and users may  
17 access and request the file using the unique identification code. In other words, when  
18 items are to be made available for transmission, a first item is retrieved from the  
19 source material library, it is assigned a unique identification code, it is converted,  
20 ordered, compressed, and placed into a file and stored in the compressed data library  
21 with the assigned unique identification. Additional items are then individually  
22 processed in this same manner.

23 **g) Transmit At Least A Portion Of The File To A Remote**  
24 **Location**

25 The file (or at least a portion of the file) is then transmitted to a remote location  
26 using a transmitter (112). A transmission data converter (119) may encode data for  
27 the transmitter. (‘992 patent, 15:55-60). The transmitter places the formatted data  
28 onto a communications channel, i.e. standard telephone, ISDN, B-ISDN, microwave,

1 DBS (direct broadcast satellite), cable television systems, metropolitan area networks,  
2 local area networks, high speed modems, communication couplers, VHF, or UHF  
3 broadcasting systems. ('992 patent, Fig. 2b; 4:61-63;15:65-16:15 and 16:53-69). The  
4 type of transmitter used will depend upon the particular communication channel being  
5 utilized for transmission. ('992 patent, 16:53-61).

6 **h) Receive The Compressed, Digital Information**

7 A reception system is located at the remote location. One example of the  
8 reception system is depicted in Figure 6 of the '992 patent. The reception system  
9 includes a transceiver (201) which may receive the information in the file transmitted  
10 by the transmitter as compressed, formatted data blocks (122, Figure 2b). ('992  
11 patent, 4:64-69; 17:67 - 18:8). A receiver format converter (202) may convert the  
12 compressed formatted data blocks into a format suitable for playback by the user in  
13 real time. ('992 patent, 18:9-13).

14 **i) Store (Temporarily Or For Longer Periods Of Time) At**  
15 **Least A Portion Of The Received Information**

16 The received, converted information may then be stored prior to decompression  
17 and prior to playback. The user may chose to play back the information at a later  
18 time, and, if so, all of the received information is stored in storage 203 ('992 patent,  
19 18:14-21). In the alternative, the information may be decompressed in real time as it  
20 is distributed by the transmission system, in which case, a portion of the received  
21 information is buffered (temporarily stored) while another portion is decompressed  
22 for immediate viewing as it is distributed by the transmission system. ('992 patent,  
23 4:68 - 5:9).

24 **j) Decompress The Information**

25 When the user requests playback, the information may be sent to the data  
26 formatter (204) which distinguishes audio information from video information. ('992  
27 patent, 18:22-26). The separated audio and video information may then be  
28 decompressed by the decompressor (208 for video information and 209 for audio



1 information). ('992 patent, 18:27-29). The time encoding of the data blocks, prior to  
2 compression, allows for the realignment of the audio and video prior to playback.  
3 ('992 patent, 8:20-23).

4 **k) Playback The Information Using Playback Controls**

5 The decompressed information may then be sent to output converters (211-214)  
6 where the information is output in real time in a format compatible with a playback  
7 device (i.e., a computer monitor, a television, or audio speakers). ('992 patent, 18:29-  
8 35). Additionally, the receiving system may include playback controls, which permit  
9 the user, for example, to play, fast forward, rewind, stop, pause, and play slow the  
10 output information. ('992 patent, 17:35-43 and 18:36-45).

11 **2. Description Of System Elements And Steps From The Figures**  
12 **And A Representative Claim Of The '992 Patent**

13 The systems and methods described above are reinforced by Figure 2a of the  
14 '992 patent, which Acacia has reproduced below.<sup>11</sup> For the convenience of the Court,  
15 Acacia has color-coded Figure 2a and the elements of representative claim 1 of the  
16 '992 patent to show the correspondence between the elements of the claim and Figure  
17 2b.

18 ///

19 ///

20 ///

21 ///

22 ///

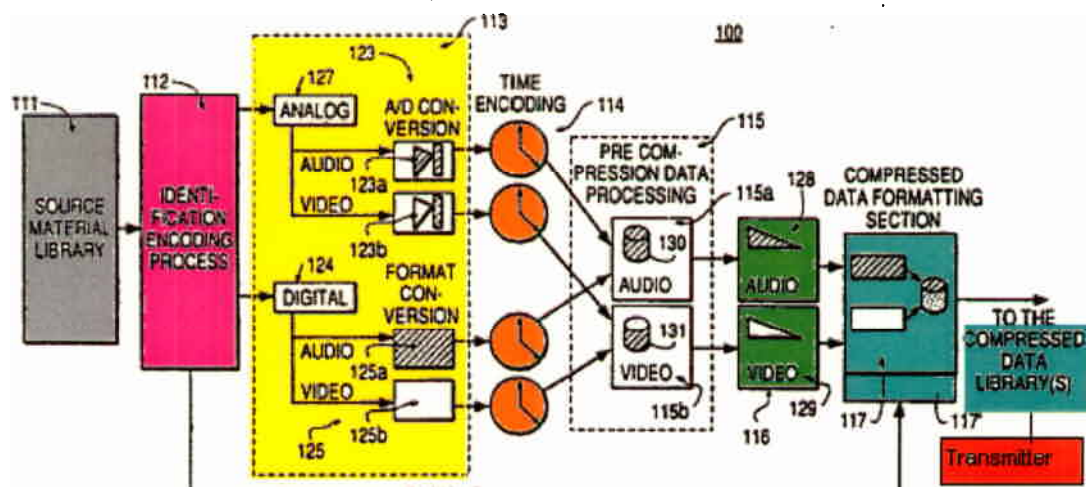
23 ///

24 ///

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25  
26  
27 <sup>11</sup> Acacia has added the "transmitter" (shown in red in the lower right corner of  
28 the Figure). The transmitter and the compressed data library are shown in Figure 2b  
of the '922 patent. Figure 2b is a continuation of the exemplary system shown in  
Figure 2a.

**Figure 2a Of The '992 Patent**



**Claim 1 Of The '992 Patent**

1. A transmission system for providing information to be transmitted to remote locations, the transmission system comprising:

library means for storing items containing information;

identification encoding means for retrieving the information in the items from the library means and for assigning a unique identification code to the retrieved information;

conversion means, coupled to the identification encoding means, for placing the retrieved information into a predetermined format as formatted data;

ordering means, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks;

compression means, coupled to the ordering means, for compressing the formatted and sequenced data blocks;

compressed data storing means, coupled to the data compression means, for storing as files the compressed, sequenced data blocks received from the data compression means with the unique identification code assigned by the identification encoding means; and

transmitter means, coupled to the compressed data storing means,

1 for sending at least a portion of one of the files to one of the remote  
2 locations.

## 3 **II. PRINCIPLES OF CLAIM CONSTRUCTION**

4 As this Court is aware, the Federal Circuit has established well-settled  
5 principles for construing patent claims in order to achieve a proper construction.  
6 Acacia has provided the case law most relevant to the claim construction issues  
7 presented in this case.

8 The claims of the patent define the scope of an invention and therefore courts  
9 begin the construction process by examining the language of the claim itself. Alloc,  
10 Inc. v. International Trade Commission, 342 F.3d 1361, 1368 (Fed. Cir. 2003);  
11 Johnson Worldwide Associates, Inc. v. Zebco Corp., 175 F.3d 985, 989 (Fed. Cir.  
12 2000).

### 13 **A. Claim Terms Are Presumed To Carry Their Ordinary And** 14 **Customary Meaning**

15 Courts indulge a “heavy presumption” that a claim term carries its ordinary and  
16 customary meaning. CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366  
17 (Fed. Cir. 2002); Johnson Worldwide, 175 F.3d at 989 (“a court must presume that the  
18 terms in the claim mean what they say, and, unless otherwise compelled, give full  
19 effect to the ordinary and accustomed meaning of claim terms.”); Alloc, 342 F.3d at  
20 1368, quoting Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364, 1367 (Fed. Cir.  
21 2003) (“‘Claim language generally carries the ordinary meaning of the words in their  
22 normal usage in the field of the invention’ at the time of the invention.”)

23 In determining what the ordinary and customary meaning of a claim term is,  
24 “the context of the surrounding words in a claim also must be considered.” Arlington  
25 Industries, Inc. v. Bridgeport Fittings, Inc., 345 F.3d 1318, 1325 (Fed. Cir. 2003). A  
26 court may “immerse itself in the specification, the prior art, and other evidence, such  
27 as the understanding of skilled artisans at the time of invention, to discern the context  
28 and normal usage of the words in the patent claim.” Alloc, 342 F.3d at 1368, citing,

1 Hoescht Celanese Corp. v. BP Chemicals, Inc., 78 F.3d 1575, 1579 (Fed. Cir. 1996).

2 Courts are cautioned, however, not to import limitations from the specification  
3 or prosecution history when discerning the ordinary and customary meaning of a  
4 claim term. Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1201 (Fed.  
5 Cir. 2002) (“Consulting the written description and prosecution history as a threshold  
6 step in the claim construction process, before any effort is made to discern the  
7 ordinary and customary meanings attributed to the words themselves, invites a  
8 violation of our precedent counseling against importing limitations into the claims.”)

9 Dictionaries and scientific treatises may also help supply the pertinent context  
10 and usage for claim construction. Alloc, 342 F.3d at 1368, citing, Texas Digital, 308  
11 F.3d at 1201 and Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1309  
12 (Fed. Cir. 1999).<sup>12</sup> Dictionary definitions may even be used by a court to establish a  
13 claim term’s ordinary meaning, so long as the dictionary definition does not  
14 contradict any definition found in or ascertained by a reading of the patent documents.  
15 CCS Fitness, 288 F.3d at 1366; Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576,  
16 1584 n. 6; and so long as the dictionary definition is consistent with the use of the  
17 words by the inventor. Texas Digital, 308 F.3d at 1204, citing, Dow Chemical Co. v.

18  
19 <sup>12</sup> Dictionaries may even be the most meaningful sources of information to aid the  
20 court in better understanding the technology and the terminology used by those skilled  
21 in the art:

22 When a patent is granted, prosecution is concluded, the intrinsic record is  
23 fixed, and the public is placed on notice of its allowed claims.  
24 Dictionaries, encyclopedias and treatises, publicly available at the time  
25 the patent is issued, are objective resources that serve as reliable sources  
26 of information on the established meanings that would have been  
27 attributed to the terms of the claims by those of skill in the art. Such  
28 references are unbiased reflections of common understanding not  
influenced by expert testimony or events subsequent to the fixing of the  
intrinsic record by the grant of the patent, not colored by the motives of  
the parties, and not inspired by litigation. Indeed, these materials may be  
the most meaningful sources of information to aid judges in better  
understanding both the technology and the terminology used by those  
skilled in the art to describe the technology.

Texas Digital, 308 F.3d at 1202-03.



1 Sumitomo Chemical Co., 257 F.3d 1364, 1372-73 (Fed. Cir. 2001) and Multiform  
2 Dessicants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1433 (Fed. Cir. 1998); See also,  
3 Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1300 (Fed. Cir.  
4 2003).

5 **B. The Presumption That Claim Terms Carry Their Ordinary And**  
6 **Customary Meaning May Be Overcome**

7 While a court begins with the ordinary and customary meaning of the claim  
8 term, it must also examine the intrinsic record to determine whether anything in the  
9 record overcomes the presumption that the term has the ordinary meaning. Arlington  
10 Industries, 345 F.3d at 1326.

11 There are limited circumstances where the “heavy presumption” that a claim  
12 term is given its ordinary and accustomed meaning may be overcome and the court  
13 may supply a definition of a claim term or phrase different than its ordinary and  
14 accustomed meaning. CCS Fitness, 288 F.3d at 1366. In each circumstance there  
15 must be textual language from the patent specification that is clearly associated with a  
16 claim term and its proffered construction. Johnson Worldwide, 175 F.3d at 989.

17 First, a claim term will not receive its ordinary meaning if the patentee acted as  
18 his own lexicographer and clearly set forth a definition of the disputed claim term in  
19 either the specification or prosecution history. Id.; Johnson Worldwide, 175 F.3d at  
20 990.

21 Second, a claim term will not carry its ordinary meaning if the intrinsic  
22 evidence shows that the patentee (i) distinguished that term from prior art on the basis  
23 of a particular embodiment, (ii) expressly disclaimed subject matter, or (iii) described  
24 a particular embodiment as important to the invention. CCS Fitness, 288 F.3d at  
25 1366-67.

26 In evaluating whether this second situation exists sufficient to depart from the  
27 ordinary means of a term, a court must proceed with caution—on the one hand, a  
28 court must interpret the claims in light of the specification, however, on the other

1 hand, a court must avoid impermissibly importing limitations from the specification  
2 into the claims. Alloc, 342 F.3d at 1370. Only statements which evince a “clear and  
3 unmistakable surrender of subject matter” or a “clear disavowal of claim scope” will  
4 cause a claim term to be given a meaning different than its ordinary meaning.  
5 Teleflex, Inc. v. Ficosa North America Corp., 299 F.3d 1313, 1325 (Fed. Cir. 2002)  
6 (“We hold that claim terms take on their ordinary and accustomed meanings unless  
7 the patentee demonstrated an intent to deviate from the ordinary and accustomed  
8 meaning of a claim term by redefining the term or by characterizing the invention in  
9 the intrinsic record using words or expressions of manifest exclusion or restriction,  
10 representing a clear disavowal of claim scope.”); Cordis Corp. v. Medtronic AVE,  
11 Inc., 339 F.3d 1352, 1363 (Fed. Cir. 2003) (“To invoke argument-based estoppel, the  
12 prosecution history must evince a ‘clear and unmistakable surrender of subject  
13 matter.’”); See also, IMS Tech., Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1439  
14 (Fed. Cir. 2000); Middleton, Inc. v. Minnesota Mining and Manufacturing Co., 311  
15 F.3d 1384, 1388 (Fed. Cir. 2002).

16 Further, although it is proper to use the specification to interpret what the  
17 patentee meant by a word or a phrase in the claim, a court cannot give a claim term a  
18 meaning different than its ordinary meaning simply because the specification  
19 describes a certain embodiment as being preferred or only describes one or a few  
20 embodiments. E.I. Du Pont De Nemours & Co. v. Phillips Petroleum Co., 849 F.2d  
21 1430, 1433 (Fed. Cir. 1988) (“It is entirely proper to use the specification to interpret  
22 what the patentee meant by a word or phrase in the claim. But this is not to be  
23 confused with adding an extraneous limitation appearing in the specification, which is  
24 improper.”);<sup>13</sup> If, however, the specification makes clear that the claimed invention is  
25 narrower than the claim language might imply, it is entirely permissible and proper to

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27 <sup>13</sup> A patentee need not “describe in the specification every conceivable and  
28 possible future embodiment of his invention.” CCS Fitness, 288 F.3d at 1366,  
quoting, Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1344 (Fed. Cir. 2001).

1 limit the claims. Alloc, 342 F.3d at 1366, citing, SciMed Life Sys., Inc. v. Advanced  
2 Cardiovascular Sys., Inc., 242 F.3d 1337, 1345 (Fed. Cir. 2001).

3 Next, a claim term will not have its ordinary and accustomed meaning if the  
4 term “chosen by the patentee so deprives the claim of clarity.” CCS Fitness, 288 F.3d  
5 at 1367. In such cases, the court must construe the claim term consistent with the  
6 meaning found in the intrinsic patent record. J.T. Eaton & Co. v. Atlantic Paste &  
7 Glue Co., 106 F.3d 1563, 1568 (Fed. Cir. 1997) (Because “[the disputed claim term]  
8 is a term with no previous meaning to those of ordinary skill in the prior art[,] its  
9 meaning, then, must be found [elsewhere] in the patent.”); North American Vaccine,  
10 Inc. v. American Cyanamid Co., 7 F.3d 1571, 1576 (Fed. Cir. 1993) (using the  
11 specification for guidance “when the meaning of a claim term is in doubt.”)

12 Lastly, claim terms which are phrased using the word “means” give rise to a  
13 presumption that the inventor used the term advisedly to invoke the statutory  
14 mandates for means-plus-function clauses set forth in 35 U.S.C. § 112, ¶ 6. Sage  
15 Products, Inc. v. Devon Industries, Inc., 126 F.3d 1420, 1427 (Fed. Cir. 1997). This  
16 presumption is not conclusive. Where “a claim recites a function, but then goes on to  
17 elaborate sufficient structure, material, or acts within the claim itself to perform  
18 entirely the recited function, the claim is not in a means-plus-function format.”  
19 Enviroco Corp. v. Clestra Cleanroom, Inc., 209 F.3d 1360, 1365 (Fed. Cir. 2000),  
20 quoting, Sage Products, 126 F.3d at 1427-28; Cole v. Kimberly-Clarke Corporation,  
21 102 F.3d 524, 531 (Fed. Cir. 1196); Rodime PLC v. Seagate Technology, Inc., 174  
22 F.3d 1294, 1302-03 (Fed. Cir. 1999).

23 In construing means-plus-function claim limitations, a court must first define  
24 the particular function claimed, and thereafter identify “the corresponding structure,  
25 material, or acts described in the specification.” Sage Products, 126 F.3d at 1428.<sup>14</sup>

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26  
27 <sup>14</sup> Whether or not the specification adequately sets forth structure corresponding  
28 to the claimed function necessitates consideration of that disclosure from the  
viewpoint of one skilled in the art. Budde v. Harley-Davidson, Inc., 250 F.3d 1369,  
1376 (Fed. Cir. 2001), citing, North American Vaccine, 7 F.3d 1579; In re Ghiron,

Means-plus-function claim limitations are construed, pursuant to 35 U.S.C. § 112, ¶ 6, as covering “the corresponding structure, material, or acts described in the specification and equivalents thereof.”

In the end, a persuasive claim construction is one which defines terms in the context of the whole patent:

Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. [citation omitted]. The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction. [citations omitted]. A claim construction is persuasive, not because it follows a certain rule, but because it defines terms in the context of the whole patent.

Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1250 (Fed. Cir. 1998).

### **III. ACACIA'S CONSTRUCTION OF THE EIGHT CLAIM PHRASES AT ISSUE**<sup>15</sup>

#### **A. “REMOTE LOCATIONS”**

The phrase “remote locations” is found in claims 1, 19, 22, 25, 41, 47, and 54 of the '992 patent. (Exhibit 4 shows the use of this phrase throughout the '992 patent). The phrase “remote locations” should be construed to mean “positions or sites distant in space from the position(s) or site(s) of the transmission system.”

In claim 1, the phrase “remote locations” is used in the phrases:

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442 F.2d 985, 991 (C.C.P.A. 1971) (stating that “if such selection would be ‘well within the skill of persons skilled in the art’, such functional-type block diagrams may be acceptable and, in fact, preferable if they serve in conjunction with the rest of the specification to enable a person skilled in the art to make such a selection and practice the claimed invention with only a reasonable degree of routine experimentation.”) Failure to disclose adequate structure corresponding to the recited function results in the claim being of indefinite scope and thus invalid under 35 U.S.C. § 112 (1). Thus, such a challenge to the patent requires a finding by clear and convincing evidence that the specification lacks disclosure of sufficient structure to be understood by one skilled in the art as being adequate to perform the recited function. Budde, 250 F.3d at 1376-77.

<sup>15</sup> Exhibit 3 to Acacia's Appendix shows Acacia's construction for each of these initial eight phrases at issue in this brief.